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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,782	08/11/2000	Donald S. Forsyth	50495-1	9627

25277 7590 12/17/2001

NATIONAL RESEARCH COUNCIL OF CANADA
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CANADA

EXAMINER

LUDLOW, JAN M

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 12/17/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/635,782

Applicant(s)

FORSYTH, DONALD S.

Examiner

Jan M. Ludlow

Art Unit

1743

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Claims 1-9 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. In claim 1, "micro volume" is unclear because the term has not been defined as to the metes and bounds of the volume intended.

Claims 7 and 18 contain the trademark/trade name Carbowax. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-9 and 12 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites "means for introducing a sample...into the enclosure means" but no such means are taught. On page 6, lines 19-20, it is indicated that sample is

introduced into the airtight enclosure before it is made airtight, but no means for doing so are described. With respect to claim 12, the method of claim 10 is not described as taking place in a gas tight enclosure as there is no description of placing the sorbent in a solvent and desorbing in an airtight enclosure, but rather the airtight enclosure is opened after adsorption and the sorbent removed from the airtight enclosure for the desorption step (see, e.g., p. 6, lines 23-26).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pawliszyn.

Pawliszyn teaches a vial containing a sample and sealed with a septum having a syringe inserted therein with a sorbent fiber as claimed extending from a protective needle into the vial to sorb analytes (see, e.g., abstract lines 10-13, col. 7, lines 33-53). The sorbent is retracted into the needle and desorbed in the

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inlet of a gas chromatograph, i.e., into a gaseous solvent (col. 4, lines 45-50). In addition, the method can be used to extract analytes for analysis by liquid chromatography, flow injection analysis (col. 7, lines 62-67). In the prior art, solid phase extraction devices are contacted with solvents to desorb analytes into liquid aliquots for injection into chromatographs (col. 1, lines 50-63).

Pawliszyn fails to teach ~~reaches~~ "means for introducing a sample...into the enclosure means" or desorption into a "micro volume".

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a funnel, beaker, pipet or other sample introduction means for putting the sample into the vial before sealing as was known in the art. With respect to claim 10, it would have been obvious to desorb in a small volume of carrier gas (solvent) in order to provide a concentrated plug of sample to optimize separation and peak resolution as was known in the art. Alternatively, it would have been obvious to of ordinary skill in the art at the time the invention was made to desorb onto a liquid solvent, such as an organic solvent, in order to provide a liquid sample as taught in the prior art in order to provide a sample for LC or FIA as taught by Pawliszyn. It would have been obvious to desorb into a small volume proportionate to the small volume of sorbent taught by Pawliszyn in order to provide a concentrated plug of sample to optimize separation and peak resolution as was known in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is

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(703) 308-4039. The examiner can normally be reached on Monday-Thursday,
11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the
examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The
fax phone numbers for the organization where this application or proceeding is
assigned are (703) 305-7718 for regular communications and (703) 305-3599 for
After Final communications.

Any inquiry of a general nature or relating to the status of this application
or proceeding should be directed to the receptionist whose telephone number is
(703) 308-0661.



Jan M. Ludlow
Primary Examiner
Art Unit 1743

jml
December 13, 2001